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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,020	12/02/2003	Vito James Carlucci	884.0211USU	2654

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EXAMINER	
GIBSON, RANDY W	
ART UNIT	PAPER NUMBER
2841	

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/726,020	CARLUCCI ET AL.	
	Examiner	Art Unit	
	Randy W. Gibson	2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *28-30* is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/2/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What the claims mean by "positioning a user on said scale via said one or more supports" is unclear since there seems to be no embodiment disclosed that has a support that actually lifts the user off the ground and automatically places him on the surface.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Artwick et al (US # 3,811,523). Artwick et al discloses the claimed invention including a

housing (15) having a display window (Col. 4, lines 37-61) and a pad (20) overlaying the scale having a corresponding window (27), and the pad may be removable or secured to the housing (Col. 5, lines 43-64).

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Salini (US # 5,195,599). Salini discloses a foam pad (Col. 5, lines 42-48) for removably attaching to a scale (Col. 5, lines 49-59; Col. 10, lines 39-50) that also has a window cut into it (Col. 8, lines 44-48). Although not expressly stated, the examiner takes official notice that all modern supermarket scales have a display (for displaying price/weight), an input (cash register keyboard), and a memory. See *MPEP* § 2144.03. It is also noted that the window 74 is not for the express purpose of allowing one to see the display, but the examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, there appears to be no claimed structural difference.

5. Claims 9-12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Gubitose (US # 6,426,471). Gubitose discloses an ergonomic scale (Col. 2, line 66-67; Col. 3, lines 30-58). Although not expressly stated, personal computer 30 inherently

has a visual display, a microprocessor controller, a memory, a power source, and a keyboard input.

6. Claims 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Levy et al (US # 4,366,873). Levy et al discloses the claimed invention including a scale that interactively tracks weight information for multiple users (Abs.).

7. Claims 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Melton, Jr. (US # 6,038,465). Melton, Jr. discloses the claimed invention including a scale that automatically tracks weight information for multiple users (Abs.).

8. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tirkkonen (US # 3,722,611). Note that a bed is inherently ergonomic, and is also used domestically since every home has one.

9. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Cary (US # 5,892,180). Cary has a support (hydraulic lift) that lifts a user and places him on the scale (properly positions him on said scale).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Artwick et al (US # 3,811,523). Artwick et al discloses the claimed invention except it does not expressly disclose that the cover is made from an antibacterial, antifungal, or hypoallergenic material. However antibacterial, antifungal, and hypoallergenic plastics are known, and since the surface of Artwick et al is intended to come into repeated contact with human skin, it would have been obvious to the ordinary practioner to include such a plastic to prevent the spread of disease or to prevent allergic reactions.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Salini (US # 5,434,367). The pad of Salini is not expressly disclosed as having an antibacterial surface. However, antibacterial and antifungal plastics are known, and since the pad of Salini is supposed to come into contact with food, it would have been obvious to the ordinary practioner to include an antibacterial surface to prevent contaminating food.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gubitose (US # 6,426,471) in view of Miyahara et al (US # 4,764,981). Gubitose discloses the claimed device except for a remote control. Miyahara et al disclose that it is known to use a remote control to control a computer (Col. 1, lines 19-23). It would

have been obvious to modify the PC of Gubitose to include a remote control for the convenience of the user.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gubitose (US # 6,426,471) in view of Nakano et al (US # 4,677,569). Gubitose discloses the claimed device except for voice activated commands. However, Nakano et al disclose that it is known to program a PC to respond to voice commands, so it would have been obvious to the ordinary practioner to modify the PC of Gubitose to accept voice commands for the convenience of the user.

15. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gubitose (US # 6,426,471) in view of Peoples (US # 4,876805) or Weber et al (US # 5,121,962). Gubitose discloses the claimed device except for the use of a viscoelastic material in the pad. However, the use of viscoelastic foam for ergonomic purposes is known as show by the example of Peoples or Weber et al, so it would have been obvious to the ordinary practioner to use a known material in the ergonomic pad of Gubitose for its intended purpose.

16. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al in view of Artwick et al. Levy et al discloses the claimed invention except for the scale cover. Artwick et al discloses that it is know to provide a scale with a removable cover for decorative purposes; therefore it would have been obvious to place a cover on

the scale of Levy et al for the same purpose. The claimed limitations that the plastic cover provides more comfort than a bare steel weighing pan, and sanitary benefits also since it can be removed and washed, does not carry any patentable weight since it is claiming an inherent property of any plastic cover without defining any additional structure. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *MPEP* § 2112.

17. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Melton, Jr. in view of Artwick et al. Melton, Jr. discloses the claimed invention except for the scale cover. Artwick et al discloses that it is know to provide a scale with a removable cover for decorative purposes; therefore it would have been obvious to place a cover on the scale of Melton, Jr. for the same purpose. The claimed limitations that the plastic cover provides more comfort than a bare steel weighing pan, and sanitary benefits also since it can be removed and washed, does not carry any patentable weight since it is claiming an inherent property of any plastic cover without defining any additional structure. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render

the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *MPEP* § 2112.

18. Claims 21-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Meyer et al (US # 6,407,351) in view of Salini (US # 5,195,599). Note that the feet of Meyer et al are vertically adjustable. It is unclear if the term "ergonomic" is a structural limitation, but if it is, then Salini discloses that it is known and obvious to place a pad on a food scale, such as the food scale of Meyer et al, to prevent produce from being bruised.

Such a pad would be inherently "ergonomic" since it seems to have the same structure as applicant's disclosed pad. As far as the limitation of being "sized and shaped for domestic use", the scale of Meyer et al seems to be approximately the same "size" and "shape" as applicant's scale; even if not, it seems self-evident that the scale of Meyer et al is inherently useful in a household kitchen. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also *MPEP* § 2112.

19. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cary (US # 5,892,180) in view of Provi (US # 4,082,153). Cary has a support (hydraulic lift) that lifts a user and places him on the scale (properly positions him on said scale). Cary does not have a way of activating the scale by taping on it in a certain location. However, Provi disclose that it is known to activate a scale by means of a kick bar. Since the scale of Cary is being used by an invalid who obviously has his hands occupied by griping the lift, then it would have been obvious to the ordinary practioner to include a kick bar with the scale of Cary for the convenience of the user.

Conclusion

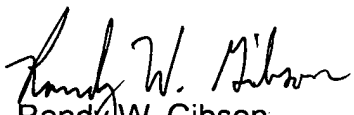
20. Claims 28-30 are allowable over the art of record. Oldendorf et al (US # 4,848,477) disclose a method of repositioning a calibration weight in response to indicators on a display that follow a pre-programmed calibration routine, and Sela (US # 5,058,691) use IR beams to detect whether an object is fully on a supermarket scale or not, but there is no teaching in the art of record to modify a scale that weighs a "user" (a whole person) to indicate to the user how to position himself on the scale.

It is unclear if claim 26 would be allowable or not since it is unclear what claim 25 is claiming.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy W. Gibson whose telephone number is (571) 272-2103. The examiner can normally be reached on Mon-Fri., 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Randy W. Gibson
Primary Examiner
Art Unit 2841